

REMARKS

1. Formal Matters

a. Status of the Claims

Claims 1-30 are pending in this application. Claims 1-30 are hereby canceled without prejudice to pursuing the canceled subject matter in a continuing application. Claims 31-42 are new. Upon entry of these amendments, claims 31-42 are pending and under active consideration. Applicants respectfully request entry of the amendments and remarks made herein into the file history of the present application.

b. Amendments to the Claims

New claim 31 recites a nucleic acid consisting of 19 to 140 nucleotides, support for which may be found throughout the application including paragraphs 0049-0050 of the specification as originally filed. New claim 31 also recites that the sequence of the nucleic acid may comprise at least 19 consecutive nucleotides of SEQ ID NO: 6527, support for which may be found at Table 2, lines 6980-7076 as originally filed.

Claim 31 is also amended to recite that the nucleic acid may be an RNA equivalent of (a), support for which may be found at Table 2, lines 6980-7076 as originally filed.

Claim 31 is also amended to recite that the nucleic acid may be a sequence at least 80% identical to (a) or (b), support for which may be found at claim 1 and paragraph 0053 of the specification as originally filed.

Claim 31 is also amended to recite that the nucleic acid may be the complement of any one of (a)-(c), support for which may be found at Table 2, lines 6980-7076 as originally filed.

New claim 32 recites the nucleic acid of claim 31, wherein the at least 19 nucleotides comprises the sequence of SEQ ID NO: 15, support for which can be found at Table 1, line 724 as originally filed.

New claim 33 recites a nucleic acid of claim 31, wherein the nucleic acid consists of 19 to 24 nucleotides, support for which can be found at paragraph 0050 of the specification as originally filed.

New claim 34 recites a nucleic acid with a sequence consisting of (a) SEQ ID NO: 6527; (b) an RNA equivalent of (a); (c) a sequence at least 80% identical to (a) or (b); or (d) the

complement of any one of (a)-(c), support for which may be found as described above for new claim 31.

New claim 35 recites a nucleic acid of claim 34, wherein the at least 19 nucleotides comprises the sequence of SEQ ID NO: 15, support for which can be found as described for new claim 32.

New claim 36 recites a nucleic acid of claim 34, wherein the nucleic acid consists of 19 to 24 nucleotides, support for which can be found as described for new claim 33.

New claim 37 recites a nucleic acid of claim 32, wherein the nucleic acid is an RNA, support for which can be found at Table 2, lines 6980-7076 as originally filed.

New claim 38 recites a nucleic acid of claim 35 wherein the nucleic acid is an RNA, support for which can be found at Table 2, lines 6980-7076 as originally filed.

New claim 39 recites a vector comprising an insert, wherein an insert consists of the nucleic acid of claim 31, support for which can be found at paragraphs 0043-0045 of the specification as originally filed.

New claim 40 recites a vector comprising an insert, wherein an insert consists of the nucleic acid of claim 34, support for which can be found at paragraphs 0043-0045 of the specification as originally filed.

New claim 41 recites a probe comprising an insert, wherein an insert consists of the nucleic acid of claim 31, support for which can be found at paragraph 0043 of the specification as originally filed.

New claim 42 recites a probe comprising an insert, wherein an insert consists of the nucleic acid of claim 34, support for which can be found at paragraph 0043 of the specification as originally filed.

c. Election/Restrictions

At page 2 of the Office Action, the Examiner requires restriction to one of the following inventions under 35 U.S.C. § 121:

- I. Claims 1-10, 17-29, drawn to a bioinformatically detectable isolated oligonucleotide.
- II. Claim 30, drawn to a method for bioinformatic detection of microRNA.

Applicant elects without traverse Group I, which now is considered claims 31-42, drawn to an isolated nucleic acid, a vector comprising the nucleic acid, and a probe comprising the nucleic acid.

The Examiner did not include claims 11-16 in either of the above groups, because it is allegedly unclear what Applicant is seeking to claim and the Examiner was hence unable to ascertain to which group(s) claims 11-16 belong. At page 2 of the Office Action, the Examiner requires correction of the alleged lack of clarity. Claims 11-16 are canceled, making the requested correction moot.

d. Restriction to a Single Nucleotide Sequence

At pages 4-6 of the Office Action, the Examiner requires election of one sequence from the instant claims for prosecution on the merits with Group I under 35 U.S.C. § 121 and 37 C.F.R. § 1.141. Applicant elects with traverse nucleic acids related to SEQ ID NO: 6527.

The Examiner is permitted under 35 U.S.C. § 121 to issue a restriction requirement between independent and distinct inventions. However, the Director has partially waived the requirements of 37 C.F.R. § 1.141 *et seq.* to permit a reasonable number of nucleotide sequences to be claimed in a single application. *See Examination of Patent Applications Containing Nucleotide Sequence*, 1192 O.G. 68 (November 19, 1996). It has been determined that normally ten sequences constitute a reasonable number for examination purposes absent an exceptional case. *See* MPEP 803.04.

The Examiner has failed to demonstrate that the claimed sequences are an exceptional case necessitating that the number of sequences to be selected be less than ten. Applicant respectfully submits that the Examiner is impermissibly disregarding the waiver of 37 C.F.R. § 1.141 *et seq.* Accordingly, Applicant respectfully requests reconsideration of the restriction requirement and the opportunity to elect up to ten sequences for further prosecution.

e. Restriction to a Single Target Gene

At pages 7-8 of the Office Action, the Examiner requires election of a single target gene under 35 U.S.C. § 121 and 37 C.F.R. § 1.141. Applicant elects without traverse target gene TNFRSF6 which has the sequence of SEQ ID NO: 5544.

2. Conclusion

Applicant respectfully submits that the instant application is in good and proper order for allowance and early notification to this effect is solicited. If, in the opinion of the Examiner, a

telephone conference would expedite prosecution of the instant application, the Examiner is encouraged to call the undersigned at the number listed below.

Respectfully submitted,

POLSINELLI SHALTON WELTE SUELTHAUS PC

Dated: November 22, 2006

By: /Teddy C. Scott, Jr., Ph.D./
Teddy C. Scott, Jr., Ph.D.
Registration No.: 53,573
Customer No.: 37808

POLSINELLI SHALTON WELTE SUELTHAUS PC
180 N. Stetson Ave., Suite 4525
Chicago, IL 60601
312.819.1900 (main)
312.873.3613 (direct)
312.602.3955 (efax)
tscott@pswslaw.com